



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/423,387	04/25/95	KEMPF	D 4681.US.C4

ART UNIT	PAPER NUMBER
1203	19

DATE MAILED: 10/13/95

EDWARD H. GORMAN, JR.  
ABBOTT LABORATORIES  
D-377, AP&D  
100 ABBOTT PARK ROAD  
ABBOTT PARK, IL 60064-3500

12M2/1013

FAN, J EXAMINER

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.  | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____   |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1-7, 9, 10, 12, 15, 18, 19, 29-32 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-7, 9, 10, 12, 15, 18, 19, 29-32 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1835 C.D. 11; 453 O.G. 213.
14. ☐ Other

**EXAMINER'S ACTION**

Serial Number: 08/423,387

-2-

Art Unit: 1203

Claims 1,2,12,15 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

1. The inclusion of the proviso statement is confusing. Are there two provisos or one proviso with two conditions fulfilled at the same time. Furthermore in the proviso statement Z lacks antecedent basis. It appears that the definition for Z should proceed the proviso statement. Applicants are requested to clarify why the proviso statement is included. Claim 2 appears to conflict with the proviso statement of claim 1.

2. The term "N-protecting group" is beyond the enablement.

3. Claims 12,15 are beyond the enablement since the scope of the claims are much more than claim 29 which the applicants stated that there are in-vivo test.

Claims 1-7,9-10,12,15,18-19,29,30-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending applications Serial No. 08/288,857; 08/185,666; 08/420,174; 08/455,458; 08/455,922; 08/455,052. Although the conflicting

Serial Number: 08/423,387

-3-

Art Unit: 1203

claims are not identical, they are not patentably distinct from each other because they contain overlapping subject matter.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Applicants' PTO-1449 and the accompany references are noted with appreciation. The references have been placed in the file.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANE FAN whose telephone number is (703) 308-4705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JTF SEPTEMBER 27, 1995

  
JANE FAN  
PRIMARY EXAMINER  
GROUP 1200